

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JEFFREY E. TOYCEN, DARRYL L. ASPEY  
and DARIN J. GOODWILER

---

Appeal No. 1999-2734  
Application No. 08/644,170<sup>1</sup>

---

ORDER REMANDING TO EXAMINER

---

Effective April 21, 1995, 37 CFR § 1.192(c)<sup>2</sup> was amended to provide as follows (underlining added for emphasis):

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending

---

<sup>1</sup> Application for patent filed May 10, 1996.

<sup>2</sup> 60 Fed. Reg. 14518 (Mar. 17, 1995), 1173 Off. Gaz. Pat. & Trademark Office 62 (Apr. 11, 1995).

Appeal No. 1999-2734  
Application No. 08/644,170

appeal. (underlining added for emphasis).

The Appeal Brief filed October 21, 1998 (Paper No. 11) is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rule pertaining to both the "real party in interest" and "related appeals and interferences."

The Manual of Patent Examining Procedure (MPEP) § 1206 (7th ed., rev. 1, no. 1, July 1998) states:

If appellant does not name a real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed. . . .

. . . While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest.

The MPEP § 1206 further states:

If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case.

The examiner may presume that the real party in interest is the party named in the caption of the brief and that there are no related appeals and interferences, if applicant presents the headings but fails to provide the corresponding statements under

Appeal No. 1999-2734  
Application No. 08/644,170

the headings. Nevertheless, the examiner is encouraged to request from applicant not only the required headings but also explicit statements naming the real party in interest and identifying any related appeals and interferences in order to avoid further delays in the appeal process, since the Board will otherwise require applicant to explicitly identify the real party in interest and any related appeals and interferences.

On October 21, 1998, applicants filed an Appeal Brief (Paper No. 11). Attached thereto was an amendment to claim 1. However, the Examiner's Answer mailed January 5, 1999 (Paper No. 12) indicates that this amendment has been entered. A review of the record indicates that the amendment was not entered. Further, the amendment has not been physically entered. Furthermore, the Appeal Brief (Paper No. 11) does not comply with section 1206(9) of the Manual of Patent Examining Procedure<sup>3</sup> (MPEP), which states "[t]he copy of the claims required in the brief Appendix by 37 CFR § 1.192(c)(9) should be a clean copy and should not include any brackets or underlining as required by 37 CFR § 1.121(a)(2)."

Accordingly, it is

ORDERED that the application is remanded to the

---

<sup>3</sup> Manual of Patent Examining Procedure (7th ed., July 1998).

Appeal No. 1999-2734  
Application No. 08/644,170

examiner for:

(1) resolution of the issues set forth above regarding both the "real party in interest" and "related appeals and interferences;"

(2) notifying applicants to submit a clean and correct copy of claim 1 on appeal, or for the examiner to reproduce a correct copy of claim 1;

(3) clarifying the entry status of the amendment filed October 21, 1998, for notification to applicants in writing of the action taken; and

(3) for such further action as may be deemed appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: \_\_\_\_\_  
FRANCES C. HAN  
Program and Resource Administrator  
(703)308-9797

FCH:clm

Appeal No. 1999-2734  
Application No. 08/644,170

Ronald G. Bitner  
P.O. Box 2223 Stn D.  
Ottawa, Ontario  
K1P 5W4 Canada